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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,971	12/27/2000	Sadahiko Kondo	001695	3257

23850 7590 10/29/2002

ARMSTRONG, WESTERMAN & HATTORI, LLP
1725 K STREET, NW.
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

ROSE, ROBERT A

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/747,971

Applicant(s)
Kondo et al

Examiner
Robert Rose

Art Unit
3723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 19, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10 and 13-20 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3723

DETAILED ACTION

1. Applicant's election without traverse of Group II, claims 7-20, in Paper No. 5 is acknowledged.
2. Claims 1-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 5.
3. Claims 11-12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiply dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.
4. Claims 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 16-20 are written in narrative form. The claims should be amended to recite the method in terms of positive method steps. For instance, in claims 16 and 17 there is no positive step of rotating the grindstone, and of applying the grindstone to the workpiece to remove material, to form the chamfer.
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3723

6. Claims 7-10, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al in view of Zucker and further in view of German No. 938216. Honda et al discloses a method of providing a chamfer on upper and lower edges of a workpiece comprising substantially all of the subject matter of claim 7 except for the recitation of the particular value of static friction of the first surface. Zucker discloses a clamping device comprising a pair of clamping surfaces which are made slip-free by coating the surfaces with diamond grit in a metal binder. To provide the clamping surfaces in the method of Honda et al with a coating having a high static friction such as the diamond coating disclosed in Zucker, in order to prevent slippage, would have been obvious in view of Zucker. German No. 938216 discloses a clamping chuck having plural clamping portions on opposite sides of the workpiece for steadying the workpiece during grinding. To make the work engaging surfaces in the method of Honda et al with spaced portions to provide minimal contact with the workpiece while keeping the workpiece steady during grinding would have been obvious in view of German('216).

7. Claims 16-20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yoshikawa et al is cited to show chamfering of a workpiece held between opposed chucks. Note fluid pressure clamping device in figure 2. Chatten is cited of interest to show holding of a rubber workpiece during grinding of it's peripheral surface, by clamping it between cooperating rotatable chucks. Suben is cited to show clamping a workpiece between cooperating

Art Unit: 3723

rotatable chuck surfaces to bevel it's outer surface. Niediek(German No. 3706886), and Maejima et al(British No. 2126008) are cited of interest to show beveling of a workpiece top and bottom edges while clamped between upper and lower workholder clamps.

9. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (703) 308-1360.

IT

October 22, 2002.



ROBERT A. ROSE
PRINCIPAL EXAMINER
ART UNIT 323